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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 10019980-1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 08/31/2006

Signature Mary Elias

Typed or printed name Mary Elias

Application Number	Filed
10/016,949	12/13/2001

First Named Inventor: **Brian Fahs**

Art Unit	Examiner
2193	Kang, Insun

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 35,398
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

John P. Wagner Jr.
Typed or printed name

408-938-9060
Telephone number

8/30/06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:			
	Fahs et al.	Examiner:	KANG, I.
Serial No.:	10/016,949	Art Unit:	2193
Filed:	December 13, 2001	Confirmation No.:	7384
For:	METHOD AND SYSTEM TO ANALYZE INLINED FUNCTIONS		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicants request review of the final rejection (please see the Office Action mailed June 5, 2006) of the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

112 Rejections

According to the final rejection, Claims 1-24 are rejected under 35 U.S.C. § 112, second paragraph, because the claim limitation "identifying an inlined function in source code for a binary executable" is unclear. Applicants respectfully submit that "source code" is different from a "binary executable." Specifically, source code is compiled into a binary executable. Thus, "source code for a binary executable" refers to the source code associated with ("for") a binary executable.

Furthermore, according to the claims, the inlined function is identified in the source code. The final rejection interprets "identifying an inlined function in source code" as "identifying an inlined function in a binary executable." Applicants respectfully submit that this interpretation is incorrect because it ignores the well known distinction between source code and a binary executable and, therefore, is inconsistent not only with the plain meaning that would be given to the claim by one of ordinary skill in the art but also with the specific language of the claim.

In summary, Applicants respectfully submit that Claims 1-24 are not indefinite and request review of the 35 U.S.C. § 112, second paragraph, rejection of these claims.

102(b) Rejections

According to the final rejection, Claims 1-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hundt, "HP Caliper – An Architecture for Performance Analysis Tools." Applicants respectfully submit that essential elements needed for a *prima facie* rejection of Claims 1-24 are missing, and respectfully request review of the 35 U.S.C. §102(b) rejection of these claims.

The version of "HP Caliper" described in the Hundt reference is a performance analysis tool for binary executables (see at least the second page of that reference, starting at about line 12). As described in the background section of the instant application (page 2, lines 5-8), a shortcoming of conventional performance analysis tools such as that described by the Hundt reference is that "even if the programmer specifies in the source code that a certain function be inlined, that does not necessarily mean that the particular function will ultimately be inlined in the binary executable by the compiler." As a performance analysis tool apparently limited to binary executables, and without evidence to the contrary, the particular version of "HP Caliper" described in the Hundt reference would share the above shortcoming, and it is an object of the present claimed invention to address that shortcoming.

Applicants respectfully submit that Hundt does not show or suggest "identifying an inlined function in source code" as recited in independent Claims 1, 7 and 13 (emphasis added). If indeed Hundt teaches "identifying an inlined function" as alleged in the final rejection, Applicants respectfully submit that there is no teaching in Hundt that the inlined function is identified in source code.

Because Hundt fails to teach at least one element recited in Claims 1, 7 and 13, Applicants respectfully contend that Hundt does not anticipate Claims 1, 7 and 13. Because Claims 2-6, 8-12 and 14-24 depend on either Claim 1, 7 or 13 and recite additional limitations, Applicants also contend that Hundt does not anticipate Claims 2-6, 8-12 and 14-24. Thus, Applicants respectfully submit that an essential element needed for a *prima facie* rejection of Claims 1-24 is missing, and respectfully request review of the 35 U.S.C. §102(b) rejection of these claims.

Furthermore, Applicants respectfully contend that Hundt does not show or suggest "reading source correlation information from within said binary executable; and obtaining start and end addresses for said inlined function using said source correlation information" as recited in Claims 20 and 22 and as similarly recited in Claim 24. The final rejection cites Section 4.1 of the Hundt reference, but Applicants find no teaching in either Section 4.1 or in Hundt as a whole with regard to the limitations of Claims 20, 22 and 24. Hundt mentions that function entry points are identified by analysis of unwind information tables (e.g., exception tables), procedure lookup tables, and the symbol table (please see step 2 in Section 4.1 of Hundt). Even presuming that the functions referred to by Hundt are inlined functions and that the entry points referred to by Hundt are addresses for the functions, Applicants respectfully assert that Hundt does not show or suggest using source correlation information to obtain addresses for inlined functions. Thus, Applicants respectfully submit that an essential element needed for a *prima facie* rejection of Claims 20, 22 and 24 is missing, and respectfully request review of the 35 U.S.C. §102(b) rejection of these claims.